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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/305,984	05/05/99	NOVAK	R 1340-1-016-N

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EXAMINER

LEE, L

ART UNIT

PAPER NUMBER

1645

12

DATE MAILED:

11/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/305,984

Applicant(s)

Novak et al

Examiner

Li Lee

Group Art Unit

1645



☒ Responsive to communication(s) filed on Sep 6, 1900

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 34-39, 68, and 69 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 34-39, 68, and 69 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Applicant's amendment filed on Sep 06, 2000 (Paper Number 11) has been received and entered. Claims 1-33 and 40-67 have been canceled, claim 34 been amended, and new claims 68-69 have been added, consequently claims 34-39 and 68-69 are pending in the instant application.
2. The rejection of claims 34-39 under 35 U.S.C. 102(b) as being anticipated by Williamson et al (J Bacteriology 114 (1): 105-13, 1980) is maintained and applied to the newly added claims 68-69 for reasons made of record in Paper No 10, mailed 08/01/00.

In response to applicant's argument that it is unreasonable to assume that all of the cells of Williamson and Tomasz have a defective His-Asp phosphorelay pathway, it is noted that Novak et al clearly indicate that vancomycin tolerance in mutant *Streptococcus pneumoniae* is due to the defective His-Asp phosphorelay pathway (entire article). Therefore, one skill in the art can conclude that the vancomycin tolerant mutant *Streptococcus pneumoniae* of Williamson and Tomasz is a His-Asp phosphorelay pathway defective bacterial cell. Since the US Patent Office does not have the facilities for examining and comparing applicants' ~~product~~^{method} with the ~~product~~^{product} of the prior art reference, the burden is on applicants to show an unobvious distinction between the material structural and functional characteristics of the claimed ~~product~~^{method} and the ~~product~~^{method} of the prior art. Applicant has not ~~provide~~^{provided} any evidence to ~~show~~^{show} that the vancomycin tolerant mutant *Streptococcus pneumoniae* of Williamson and Tomasz is not due to the His-Asp phosphorelay pathway ^{being} defective. In response to applicant's argument that Williamson and Tomasz only provide

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cells that are vancomycin tolerant, it is noted that Williamson and Tomasz also teach a method of using the vancomycin tolerant cell that ~~has~~^{has} a defective His-Asp phosphorelay pathway (Materials and Methods, e.g., Susceptibility tests, Selection of tolerant, autolytic mutants, and Assay for release of wall material).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Status of Claims

4. No claims are allowed. All claims stand rejected.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Li Lee
November 20, 2000


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600